

P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re: Paul M. Scopton Confirmation No.: 8323
Serial No.: 09/498,104 Examiner: M. DeSanto
Filing Date: February 4, 2000 Group Art Unit: 3763
Docket No.: 1001.1375101 Customer No.: 28075
For: FLUID INJECTABLE SINGLE OPERATOR EXCHANGE CATHETERS AND
METHODS OF USE

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL REPLY BRIEF UNDER 37 C.F.R. § 41.41

CERTIFICATE FOR ELECTRONIC TRANSMISSION:

The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 6th day of March 2009.

By Kathleen L. Boekley
Kathleen L. Boekley

Dear Sir:

Pursuant to 37 C.F.R. § 41.41, Appellant hereby submits this Reply Brief in response to the Supplemental Examiner's Answer mailed on January 7, 2009. Remarks begin on page 2.

REMARKS

1. Claims 1-5 are patentable over Sirhan (U.S. Patent No. 5,984,945).

The Examiner maintains that the interpretation of the prior art is within the ordinary and customary meaning of the claim terms, and asserts that the “major difference is the examiner using the broadest reasonable interpretation for terms like ‘connected’ and ‘fluidly communication’.” If the Examiner is asserting that the major difference between Sirhan and independent claim 1 is the interpretation of “connected” and “fluid communication”, Appellants disagree. Independent claim 1 recites a number of elements which Sirhan fails to teach, including a tubular member that (1) is connected to the shaft, (2) extends proximally from the guidewire port, (3) is external to but parallel with the shaft, and (4) is axially aligned with the guidewire lumen. Appellants have previously argued this point in, for example, the Reply Brief filed June 17, 2008, in the paragraph bridging pages 2-3.

Regarding claim 5, the Examiner asserts “Sirhan has a smaller distal guidewire lumen portion and thus would be sized to restrict fluid flow.” Appellants disagree. As discussed previously, MPEP 2112 IV clearly states, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.’ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).” Appellants submit that a guidewire lumen having a smaller distal portion than the proximal portion does not support the assertion that the guidewire lumen is necessarily “sized to restrict flow about the guidewire disposed therein”, as recited in claim 5. Nothing in Sirhan teaches or suggests such an inherent property of the distal guidewire lumen portion. Further, the Examiner has failed to provide any basis in fact and/or technical reasoning to support the assertion that a guidewire lumen with a distal portion smaller than a proximal portion necessarily has the structure to restrict flow about a guidewire.

Sirhan thus does not teach each and every limitation of the instant claims, as is required for anticipation under 35 U.S.C. §102. Withdrawal of the rejection is respectfully requested.

2. Claims 1-5, and 7 are patentable over Crittenden et al. (U.S. Patent No. 4,988,356).

The Examiner maintains that the plain and ordinary meaning of the claim terms and prior art have been used in the rejection, and asserts that Appellants are giving special meaning to the

terms and reading limitations from the specification into the claims. Appellants disagree. Rather than reading limitations from the specification into the claims, Appellants are referring to the written description to provide the context in which "guidewire port" is used, as specifically provided for in MPEP 2111.01. This MPEP section clearly states that it is this context as well as the customary use by those skilled in the art that determines the interpretation of the claim terms. In the Reply Brief filed June 17, 2008, on page 4, Appellants provided a quote from the written description that gives the context in which "guidewire port" is used. This context, in addition to the customary use of "guidewire port" by those skilled in the art clearly show that the slit 28 in the catheter 10 of Crittenden et al. does not have the identical structure and thus would not be interpreted by one of ordinary skill in the art as the claimed guidewire port. Crittenden et al. thus fail to teach each and every limitation of independent claim 1 and the claims dependent thereon. Withdrawal of the rejection is respectfully requested.

3. Claims 1-5 and 7-9 are patentable over Horzewski et al. (U.S. Patent No. 4,771,777).

The Examiner has not provided further remarks regarding the Horzewski et al. reference. Appellants maintain that Horzewski et al. fail to teach or contemplate the limitations of the claims for the reasons set forth in the Appeal Brief and Reply Briefs already on file. Withdrawal of the rejection is respectfully requested.

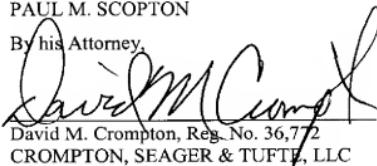
For the reasons stated above, the rejections of claims 1-5 and 7-9 under 35 U.S.C. §§ 102(b) and 102(e) should be reversed.

Date: 3/6/09

Respectfully submitted,

PAUL M. SCOPTON

By his Attorney,



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